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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,951	07/14/2003	David S. Abdallah	PRIV-004/02US 307640-2030	6422
22903 7590 04/27/2009 COOLEY GODWARD KRONISH LLP ATTN: PATENT GROUP Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			EXAMINER JOHNS, CHRISTOPHER C	
			ART UNIT 3621	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/618,951	<b>Applicant(s)</b> ABDALLAH ET AL.	
	<b>Examiner</b> Christopher C. Johns	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7,21-31 and 35-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,21-31 and 35-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/26/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This Office Action is given Paper No. 20090408 for reference purposes only.
2. This Office Action is in response to the Request for Continued Examination of 26 February 2009.
3. All references to the capitalized version of “Applicant” refer specifically to the Applicant or Applicants of record in the instant application. Any references to lowercase versions of “applicant” or “applicants” refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. Claims 1-4, 6, 7, 21-31, and 35-45 are pending.

### ***Information Disclosure Statement***

5. The information disclosure statement filed 26 February 2009 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the European Document (1,128,335, to Döbel, Klaus) was not provided in English. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the

statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 29-31, 35-37, 40, and 41-45 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 29 recites “receiving a request for a travel permission information from a personal identification device...the authentication excluding biometric information”. The Examiner cannot locate, in the specification as originally filed, the step of providing authentication without providing biometric information. The Examiner notes that MPEP §2173.05(i) recites “The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement”.

8. Claim 41 suffers from the same issue - “travel permission information excluding biometric information”.

9. Claims 41 and 44 recite “substantially at a time of ignition of a vehicle”, which cannot be located in the specification as originally filed.

Claim 43 recites “inhibiting output of a signal to a kill switch...”, which cannot be located in the specification as originally filed.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 29-31, 35-37, 40-42, and 45 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 29 recites “including an authentication of the biometric information...the authentication excluding biometric information”. A person having ordinary skill in the art would not understand how the process of authenticating a certain kind of data would not include the data.

13. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

***Response to Amendment***

14. The amendment filed 17 June 2008 is objected to under 35 U.S.C. §132(a) because it introduces new matter into the disclosure. 35 U.S.C. §132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the drawings do not appear to have any support in the specification.

15. Upon further review of the claimed invention and the specification's embodiments, the Examiner notes that the specification does not contain support for at least the GPS receiver, fingerprint sensor, or speaker (in figure 7) or for the entirety of figure 8. The Amendment also appears to introduce new matter into the specification, with the three new paragraphs including much of the same material contained in figures 7 and 8.

16. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Specification***

17. The amendment filed 17 June 2008 is objected to under 35 U.S.C. §132(a) because it introduces new matter into the disclosure. 35 U.S.C. §132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the three paragraphs inserted between paragraphs 112 and 113.

18. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 1-4, 6, 7, 21-31, and 35-40 are rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent 6,085,976 (“Sehr”).

21. As per claims 1, 21, and 29, Sehr discloses:

22. institution for researching and recording identity and at least one travel privilege for individuals (figure 3, "Cardholder/Passenger Background");

23. database maintained by institution for associating identified individuals' names (figure 3, "Cardholder/Passenger Background"), assigned asymmetric key pair (figure 3, "Digital Signature"), at least one travel privilege (figure 3, "Selection Transport/Service")

24. privilege including destination restriction, date and time restriction, mode of transportation restriction (Figure 3, "Airplane Railroad Ship Other"), operator restriction, expiration date (inherent in the use of transportation tickets);

25. travel privilege certificate associated with travel privilege and identified individual (column 2, line 65, "traveler's permit");

26. personal identification device including means for authenticating at the personal identification device the identified individual based on a biometric (figure 1, reference 1, 11, 12, 13);

27. receiving a request for a travel permission information from a personal identification device associated with the user, the request including an authentication of the biometric

information of the user performed at the personal identification device, the authentication excluding biometric information (Abstract, "Biometrics information of cardholders...can optionally be encoded");

28. sending travel permission information associated with the user based on the authentication, the travel permission information being encrypted based on an asymmetric key pair (column 31, lines 19+ - "public key technology...can also be used to store a public key certificate in the passenger card").

29. As per claims 2-4, Sehr discloses as above, and further discloses:

30. certificate comprising name, date, time, mode of transportation, type of privilege, issue date, expiration date fields, unique serial number, and a digital signature created by issuer of certificate (column 15, lines 15-37 - "electronic representation of tickets...seat assignments...carrier...date and time...unique ticket number...name and address...selected information about the carrier or itinerary"; column 31, lines 19+ - "public key technology...can also be used to store a public key certificate in the passenger card");

31. modes of transportation include train, bus, car, airplane, or ship (column 7, lines 45-47 - "airplanes, railroads, ships, automobiles, subways, buses, or rental cars");

32. type of privilege includes reservation ticket, boarding pass, port-of-entry permission, vehicle operator permission (column 7, lines 47-53 - "reservations...electronic ticketing...transportation support").

33. As per claims 6, 7, and 22, Sehr discloses as above, and further discloses:



34. means for communicating programmed to download travel privilege certificate to said personal identification device, download a computing mechanism onto the personal identification device, download a digital certificate and asymmetric key pair for the individual into the personal identification device, and transmit at least one travel privilege certificate from said personal information device (column 6, lines 39-51 - "write information into the card"; column 19, lines 3-5 - "Read/Write means refer to the retrieving of data from or the loading of data into the passenger card"; figure 1, reference number 12);
35. means for recording at least one notable event on said personal identification device (column 30, line 55 - "audit trail about the data and information stored in the card, authentications and verifications...");
36. means for storing at least one travel privilege certificate on said personal information device (Abstract, "cards so as to automatically compile...store and activate a traveler's permit for transportation and other travel service");
37. at least one application audit log on said personal identification device (column 30, line 55 - "audit trail");
38. means for receiving the biometric of the identified individual prior to the identified individual being authenticated based on the biometric and prior to transmitting the travel privilege certificate (the biometric must inherently be received by the machine before authenticating it).
39. As per claims 23-28, 30, 31, and 35-40, Sehr discloses as above, and further discloses:

40. travel permission information includes at least one of a time, mode of transportation, destination, date, operator, or expiration date restriction (column 17, lines 33-42; expiration dates are inherent in the art of travel permissions and certificates);
41. enrollment station (column 4, lines 26-44 - “also be used to compile the contents of the passenger card”).

***Claim Rejections - 35 USC § 103***

42. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

43. Claims 41-45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sehr in view of Official Notice.
44. As per claims 41-45, Sehr discloses as above, but does not disclose:
45. receiving from the personal identification device the travel permission information associated with the user at least one time when the user is operating the vehicle.
46. The Examiner takes Official Notice that reverifying information during operating was old and well-known in the art because it created more secure systems. Examples of such systems include software copy protection (whereby during the execution of a program, a user would be asked to reverify proper ownership of the program), timed logouts on websites and other information services (whereby the user would be “timed out” and would need to reenter information in order to continue using the service). These concepts enable systems to be more

secure by reverifying information - should a user borrow the piece of data necessary to gain access, reverifying the information may make it harder for that user to continue access.

47. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Sehr the idea of reverifying information, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more secure system.

48. Claims 1-4, 6, and 7 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Sehr in view of "Practical Traveler; Airline Tickets as Presents", a story from the New York Times, 21 September 1997 ("Wade")<sup>1</sup>.

49. It is the Examiner's primary position that the claims are anticipated because the above-mentioned features (i.e. "an expiration date for each at least one travel privilege") are inherent. However, if not inherent, then Wade teaches airline tickets that expire (§8). Plane tickets (as well as frequent flier miles and awards) expire in order to limit competition and sales of tickets by other vendors, and guarantee a steady flow of income to the issuing parties.

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<sup>1</sup> MPEP §2112.III authorizes a rejection under 35 USC §102 as well as 35 USC §103, when the "the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference". A §103 rejection has been made to avoid any potential questions of inherency. See *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977) "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102."

50. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Sehr the expiration dates as taught by Wade, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a steady flow of income for the ticket issuers, something that a person having ordinary skill in the art would understand as advantageous because of the financial advantages.

### ***Response to Arguments***

51. Applicant's arguments filed 26 February 2009 have been fully considered but they are not persuasive.

52. Applicant argues that Sehr does not teach a “personal identification device”. As Sehr teaches a device that authenticates users using identification, it teaches a “personal identification device” (figure 1, reference 1). Therefore, the claim language is met.

### ***Conclusion***

53. Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the Applicants, the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the Applicants, in preparing the response, fully consider the items

of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Furthermore, it must be noted that the documents cited on any enclosed PTO-892 or PTO-1449 form are cited in their entirety.

54. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

55. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

56. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621